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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/821,353

03/29/2001

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2001-0159

3776

7590

08/18/2004

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EXAMINER

ZHONG, CHAD

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/821,353

Applicant(s)

DELACRUZ, CEDRIC G.

Examiner

Chad Zhong

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Claims 1-20 are presented for examination.

2. The disclosure is objected to because of the following informalities:

Examiner could not figure out the second paragraph on page 5, majority of the numbering seem to be incorrect or not displayed on any of the figures, appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-6, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohn et al. (hereinafter Cohn), US 6,064,723.

5. As per claim 1, Cohn teaches a method for providing electronic mail message return receipts between at least one electronic mail message originator and at least one electronic mail message recipient, the method comprising:

receiving an electronic mail message which requires a video enhanced electronic mail message return receipt when received by the at least one electronic mail message recipient (Col. 32, lines 10-49);

providing the electronic mail message to the at least one electronic mail message recipient (Col. 32, lines 10-49); and

returning the video enhanced electronic mail message recipient to the electronic mail message originator, wherein the electronic mail message originator will be able to view the electronic mail

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message recipient reading the electronic mail message (Col. 32, lines 10-49).

6. As per claim 2, Cohn teaches the method of claim 1, further comprising:

capturing the at least one electronic mail message recipient on video which comprises providing a signal to a video capturing device to begin recording the electronic mail message recipient (Col. 32, lines 9-47).

7. As per claim 3, Cohn teaches the method of claim 1, wherein the video is saved in at least one format selected from the group of AVI, QUICKTIME, MPEG and REALVIDEO formats (Col. 32, lines 10-49).

8. As per claim 4, Cohn teaches the method of claim 1, wherein returning the video enhanced electronic mail message recipient to the electronic mail message originator comprises:

attaching a video file to the electronic mail message return receipt (Col. 32, lines 9-47).

9. As per claim 5, Cohn teaches the method of claim 4, wherein the video enhanced electronic mail message return receipt is an electronic mail message provided back to electronic mail message originator (Col. 32, lines 9-47).

10. As per claim 6, Cohn teaches the method of claim 1, further comprising:

determining when the at least one electronic mail message recipient starts reading the electronic mail message (Col. 14, lines 46-67; Col. 32, lines 9-47); and

determining when the at least one electronic mail message recipient stops reading the electronic mail message (Col. 14, lines 46-67; Col. 32, lines 9-47).

11. As per claim 8, Cohn teaches the method of claim 1, wherein the selected electronic mail message is tagged as requiring an electronic mail message return receipt by the electronic mail message originator (Col. 27, lines 19-27; Col. 32, lines 9-47).

*Claim Rejections - 35 USC § 103*

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al. (hereinafter Cohn), US 6,064,723 in view of 'Official Notice'.

14. As per claim 7, Cohn does not explicitly teaches the method of claim 6, further comprising:  
ending the video capture when the at least one electronic mail message recipient stops reading the electronic mail message. "Official Notice" is taken that the concept and advantages of providing for stoppage of filming upon message closure is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to include proper event signaling stoppage of filming upon message closure with Cohn because it would provide for space saving capabilities. Due to limitations in space on network nodes, it is obvious to record only the duration of time while the user is reading the message. Moreover, Cohn teaches a limited amount of time wherein the video is displayed to the email originator.

15. Claim 9-11, 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al. (hereinafter Cohn), US 6,064,723, in view of Cleron et al. (hereinafter Cleron), US 6,223,213.

16. As per claim 9, Cohn teaches a method for providing electronic mail message return receipts, the method comprising:

determining when an electronic mail message recipient has started reading an electronic mail message

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which requires an electronic mail message return receipt (Col. 14, lines 45-67);

determining when the electronic mail message recipient has stopped reading the electronic mail message (Col. 14, lines 45-67); and

providing the video of the electronic mail message recipient back to the electronic mail message's originator who specified the electronic mail message return receipt requirement (Col. 32, lines 9-48).

17. Cohn does not explicitly teaches

taking video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message.

18. Cleron teaches

taking video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message (Col. 5, lines 27-35).

19. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Cohn and Cleron because they both dealing with attaching video clips to email messages. Furthermore, the teaching of Cleron to allow

taking video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message.

would improve the communications capability for Cohn's system by allowing for the recording of recipient's facial expressions in real time as he/she is reading the email message.

20. As per claim 10, Cohn teaches the method of claim 9, wherein determining when an electronic mail message recipient has started reading a certain electronic mail message which requires an electronic mail message return receipt comprises:

detecting when the electronic mail message is opened (Col. 14, lines 45-67).

21. As per claim 11, Cohn teaches the method of claim 9, wherein determining when the electronic mail message recipient has stopped reading the electronic mail message comprises:

detecting when the electronic mail message is closed (Col. 14, lines 45-67).

22. As per claim 13, Cohn does not explicitly teach the method of claim 9, further comprising:

halting the video taking after a predetermined time limit.

23. Cleron teaches

halting the video taking after a predetermined time limit (Col. 5, lines 60-67).

24. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Cohn and Cleron because they both dealing with attaching video clips to email messages. Furthermore, the teaching of Cleron to allow

halting the video taking after a predetermined time limit

would improve the communications capability for Cohn's system by allowing for the limited time recording of recipient's facial expressions in real time as he/she is reading the email message, thus freeing up resources.

25. As per claim 14, Cohn does not explicitly teach the method of claim 9, wherein taking video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message comprises:

providing a signal to a video camera to begin taking video.

26. Cleron teaches

providing a signal to a video camera to begin taking video (Col. 5, lines 27-35).



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27. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Cohn and Cleron because they both dealing with attaching video clips to email messages. Furthermore, the teaching of Cleron to allow

providing a signal to a video camera to begin taking video

would improve the communications capability for Cohn's system by allowing for recording of recipient's facial expressions in real time as he/she is reading the email message.

28. As per claim 15, Claim 15 is rejected for the same reasons as rejection to the combination of claims 1 and 9 above.

29. As per claim 16 and 17, claims 16 and 17 are rejected for the same reasons as rejection to claims 14 and 4 above respectively.

30. As per claim 18, Cohn teaches the method of claim 15, wherein the video includes audio of the electronic mail message receiver (Col. 32, lines 9-48).

31. As per claim 19, Cohn does not explicitly teach the method of claim 15, further comprising:  
providing the electronic mail message receiver the opportunity to review and cancel the video if desired by the electronic mail message receiver.

32. Cleron teaches

providing the electronic mail message receiver the opportunity to review and cancel the video if desired by the electronic mail message receiver (Col. 6, lines 50-55).

33. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Cohn and Cleron because they both dealing with attaching video clips to email messages. Furthermore, the teaching of Cleron to allow

providing the electronic mail message receiver the opportunity to review and cancel the video if desired by the electronic mail message receiver would improve the user capability for Cohn's system by allowing for editing of recorded recipient's facial expressions prior to sending out the email message.

34. As per claim 20, Cohn teaches the method of claim 15, wherein the video is provided as a link to the video file (Col. 32, lines 9-48).

35. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al. (hereinafter Cohn), US 6,064,723, in view of Cleron et al. (hereinafter Cleron), US 6,223,213, and further in view of 'Official Notice'.

36. As per claim 12, Cohn and Cleron did not teach the method of claim 9, wherein determining when the electronic mail message recipient has stopped reading the electronic mail message comprises:

detecting when the electronic mail message is minimized.

"Official Notice" is taken that the concept and advantages of providing for detection of when the electronic mail message is minimized is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to include said detection mechanism with Cohn and Cleron because it would provide for timely stoppage of video capture, thus resulting in efficiency in network storage units.

### *Conclusion*

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents and publications are cited to further show the state of the art with respect to

"Methods For Providing Video Enhanced Electronic Mail Return Receipts".

- i. US 6304897 Venkatraman et al.
- ii. US 2002/0087642 Wei et al.

- iii. US 6014689 Budge et al.
- iv. US 2002/0056123 Liwerant et al.
- v. US 2001/0004743 Krueger et al.
- vi. RFC 1889, 1996
- vii. "Screen Phone" Oct 13, 1999
- viii. "Virtual Voice's Back Door" Dec 1996

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (703) 305-0718. The examiner can normally be reached on M-F 7am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 703-305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CZ  
June 18, 2004

A handwritten signature in black ink, appearing to read "N. Effaely", with a long, sweeping vertical stroke extending downwards from the end of the name.